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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,077	10/07/2003	Takahisa Mihara	40020837-02	9930

7590 09/21/2005

Paul D. Greeley, Esq.
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.
10th Floor
One Landmark Square
Stamford, CT 06901-2682

EXAMINER

EVANS, JEFFERSON A

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/680,077	Applicant(s) MIHARA ET AL.	
	Examiner Jefferson A. Evans	Art Unit 2652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005 and 01 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 5-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 1 to 17 are pending.

Election/Restrictions

1. Applicant's election with traverse of Species Five, figure 6, in the reply filed on 6-30-2005 is acknowledged. The traversal is on the ground(s) that each of the embodiments is a common invention and it would be more expedient to prosecute all embodiments in a single application. This is not found persuasive because of the number of species, the differences in the structure of the different species, and as set forth in the election of species requirement if a generic claim is found allowable applicant will be entitled to consideration of claims that include the language of the allowed generic claim.

The requirement is still deemed proper and is therefore made FINAL.

Applicant states that claims 1-4 and 14-17 read on the elected species. The Examiner agrees as to claims 2-4 but not claims 1 and 14-17 as claims 1 and 14-17 are drawn to an embodiment in which the air-bearing device is moveable away from the disk held by the rotating shaft whereas the elected species is one in which the air-bearing device is fixed. Claims 1 and 5-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

3. The abstract of the disclosure is objected to because legal phraseology such as “means” should be avoided.
4. The title of the invention is not adequately descriptive. A new title is required that is more clearly indicative of the invention to which the claims are directed by making reference to the invention being drawn to a disk testing device which includes an air-bearing plate.
5. The disclosure is objected to because of the following informalities: on page 2 – line 10, “misresitration” is a misspelling. Claim 4 – line 9, “sad” should be -- said --.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 2 to 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Takino (U.S. 6,560,070). Takino discloses a rotating shaft (205) that holds a disk (1 or 15) selectively mounted or removed therefrom, a disk rotator (column 17 – line 21), a head positioner (213), and a slider (216) on which is formed a head (10) wherein the slider


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reads on the claimed air-bearing device and is separable from the disk by being rotated by the head positioner off the disk and onto a supporting portion (220) when transducing operations are brought to an end. The slider flying height is given as 0.1 m. The "m" appears to be an incomplete printing of the unit designation, but whether "m" is supposed to be "mm" or "mils" or "um", Takino will meet the limitation of claims 2 to 4 that the spacing between the air-bearing device and the disk be 300 microns or smaller. Recording/reproducing section (203) may read on the disk support of claims 3 and 4 and the movement of the disk via the section includes an axial component.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferson A. Evans whose telephone number is 571-272-7574. The examiner can normally be reached on Monday to Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JAE

September 17, 2005

Jefferson A. Evans
Primary Examiner
Art Unit 2652

**JEFFERSON EVANS
PRIMARY EXAMINER**